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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,622	04/11/2001	John J. Potenza	SE001U	1826

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EXAMINER
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NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/832,622

**Applicant(s)**

POTENZA, JOHN J.

**Examiner**

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-18 and 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/13/2004 has been entered.

### ***Response to Amendment***

The amendment filed 12/13/2004 has been entered. Claims 4 and 19 are canceled. Claims 1-3, 5-16 (method<sup>1</sup>), 17-18, 20-30 (method<sup>2</sup>), 31-38 (method<sup>3</sup>) are active and are treated as followed.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-3, 5-16 (method<sup>1</sup>), 17-18, 20-30 (method<sup>2</sup>), 31-38 (method<sup>3</sup>) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 5-16 (method<sup>1</sup>), 17-18, 20-30 (method<sup>2</sup>), 31-38 (method<sup>3</sup>) are vague and indefinite because it's not clear the scope of the invention. The current preamble calls for "providing transactional service information to a service provider" but the body of the claims include steps of analyzing and evaluation of the data to produce a result for apparently monitoring of the business performance. Changing the language of the

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preamble to those as shown in D'ALESSANDRO or RIORDAN et al are recommended to improve clarity since merely providing information can be achieved by step (a) alone without evaluation.

In claim 1, step (a) line 2 is confusing. (1) What is the relationship between "transaction record" from the service provider and "evaluation data" from the same service provider? Are they the same or different data? Note also that the "processor" receiving "evaluation data" in (a) and (b). (2) Are these the same "evaluation data" or different "evaluation data"? Also, step (c) calls for "correlating information from the unique transaction record and the evaluation data". (3) It's not clear what the "evaluation data" it refers? Is this the "evaluation data" of (a) from the provider or service evaluator or (b) of the service evaluator or both of steps (a) and (b)?

Claims 17 and 31 which are similar to claim 1 above, they are rejected for the same reasons set forth in claim 1 above.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-3, 6-16 (method<sup>1</sup>), 17-18, 20-30 (method<sup>2</sup>), 31-38 (method<sup>3</sup>) are rejected under 35 U.S.C. 103(a) as being unpatentable over D'ALESSANDRO in view of RIORDAN et al or vice versa.**

**As for independent method<sup>1</sup> claim 1,** D'ALESSANDRO fairly discloses a method for providing information to an organization having at least one manager, comprising:

(a) an automated evaluation processor receives evaluation data from a survey from at least one service evaluator (consumer or customer or client) {see col. 2, lines 60-67 (or c2:60-67), c5:5-10, c8:55 to c9:5};

(b) the at least one service evaluator directly contacting the evaluation processor for providing evaluation data, the data containing a unique identification (ID) of the organization {c5:45-60, c6:35-45};

(c) the evaluation processor analyzed and evaluated the survey data to evaluate the performance of the organization using a selected formula or business performance model (correlation) to produce a final compiled file (result), wherein the organization staff or manager can access the file from the evaluation process {see c3:25-40, c5:60-67, c6:1-5}. Note, on c3:35-45, D'ALESSANDRO discloses the advantages of carrying out the survey using the Internet such as fast, convenience, accessibility, availability and wide area application at the same time. Note, also on c10:8-20, D'ALESSANDRO

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also mentions immaterial modifications, such as selection of various parameters mentioned in col. 5 and col. 8-9 or other adjustments, are within the scope of the invention and/or would have been obvious to a skilled artisan.

Note that even though D'ALESSANDRO talks about evaluates current business performance of an organization, i.e. between the employees and the employer, on c5:5-20, D'ALESSANDRO mentions another embodiment of the invention, deals with an external pool of respondents, which include consumers, customers or clients of the business entity and the survey can cover areas such as customer satisfaction of the company's performance for providing service or a product {see c8:55-60, c9:1-5}. Therefore, D'ALESSANDRO fairly teaches the claimed invention except for (a) wherein the organization (service provider) provides a unique transaction record to the automated evaluation processor along with the customer supplying the data to the evaluation processor for evaluation.

In another similar method for collecting and processing marketing data using survey for general business analysis and evaluation, RIORDAN et al discloses the collection of unique transaction record of the consumer by the organization (merchant) and providing these data to an automated evaluation processor for evaluation of the consumer for the benefits of (1) cost-effectively target their marketing and (2) sales activities and (3) efficiently reach potential customers {see col. 1, lines 20-55 (or c1:20-55), c2:15-34, c9:10-65, c10:1-15}. It would have been obvious to modify the process of D'ALESSANDRO by including in the survey unique transaction record of the consumer as taught by RIORDAN et al for one of the benefits cited above.

Alternatively, the teaching of RIORDAN et al and D'ALESSANDRO are cited above. It would have been obvious to modify the teaching of RIORDAN et al by including evaluation data from a customer (service evaluator) to monitor customer's evaluation or expectations or satisfaction with respect to the company's performance as taught by D'ALESSANDRO {see c9:1-5, c1:10-15, c5:5-10}.

**As for independent claim 17 (method<sup>2</sup>), or 31 (method<sup>3</sup>),** which has similar limitations as in method claim 1, they are rejected for the same reason set forth in claim 1 above.

**As for dep. claims 2 (of 1), 18 (of 17), and 32 (of 31),** which deals with the mode for carrying out step (b) and part of (c), i.e. interactively, this is inherently included in the Internet system of D'ALESSANDRO (c3:25-45) or RIORDAN et al.

**As for dep. claims 3, 5, (of 1),** which deal with the parameters of the transaction record, i.e. including an ID of the service evaluator (customer), this is taught by D'ALESSANDRO on c6:34-45 or RIORDAN et al on Fig. 6, 60, c9:47-57.

**As for dep. claims 6 (of 1), 20 (of 17),** which deals with the parameters of the transaction record, i.e. including an ID of the at least one service provider management, i.e. employee, this is fairly taught in D'ALESSANDRO c6:34-45. Moreover, if selection of an employee of an organization is necessary for an analysis or survey, it would have been obvious to a skilled artisan to include it since D'ALESSANDRO fairly teaches the monitoring of a specific organization, or specific customer or specific employee on c6:35-45. The application of this general concept to other similar business practice to achieve similar results would have been obvious.

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**As for dep. claims 7-8, 10 (of 1), 21, 23, 24 (of 17), 33 (of 31),** which deals with the file parameter, these are rejected for the same reason set forth in claims 6 or 20 above.

**As for dep. claims 9, 11 (of 1), 22, 25 (of 17),** which deals with the file parameters, i.e. being retrieved directly to the service provider, this is inherently taught in the Internet system of D'ALESSANDRO c5:60 to c6:5 or RIORDAN et al as shown in Fig. 1, 5 and 6.

**As for dep. claims 12 (of 1), 26 (of 17), 34 (of 31),** the practice of rewarding the consumer an incentive or reward for replying to the survey to reward time and effort for filling out the survey is well known in the art . It would have been obvious to modify the process of D'ALESSANDRO in view of RIORDAN et al or vice versa by giving incentive/reward to customers who responds to survey or giving feedback for compensation of time and effort involved for responding to the survey which are critical to the success of the company.

**As for dep. claims 13 (of 1), 27 (of 17), 35 (of 31),** which deals with the means for providing the evaluation data, i.e. inquiry/response system, this is shown in D'ALESSANDRO c3:5-10, Fig. 1 (70) or RIORDAN et al Fig. 6.

**As for dep. claims 14 (of 1), 28 (of 17), 36 (of 31),** which deals with the type of system, i.e. automatic, this is taught in D'ALESSANDRO c2:60-65, Fig. 1 (20).

**As for dep. claims 15 (of 1), 29 (of 17), 37(of 31),** which deals with accessing type, i.e. by telephone, this is taught in D'ALESSANDRO c5:50-60.



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**As for dep. claims 16 (of 1), 30 (of 17), 38 (of 31),** which deals with accessing type, i.e. by internet, this is taught in D'ALESSANDRO c5:50-55 or RIORDAN et al Fig. 1.

**6. Dependent Claims 12 (of 1), 26 (of 17), and 34 (of 31) are rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as being unpatentable over D'ALESSANDRO in view of RIORDAN et al or vice versa as applied to claims 1, 3, 5-16, 17, 20-30, 31, 33-38 above, and further in view of REMLER (US 2002/0077906) or FUERST (US 6,189,029).**

The teachings of D'ALESSANDRO in view of RIORDAN et al or vice versa is cited above.

**As for dep. claims 12, 26, 34,** REMLER is cited to teach well known practice of rewarding incentive to the customer for responding to a survey or giving feedback (0017, 0074). It would have been obvious to modify the process of D'ALESSANDRO in view of RIORDAN et al or vice versa by giving incentive/reward to customers who responds to survey or giving feedback as taught by REMLER above as a means for compensation of time and effort involved for responding to the survey.

**7. Dependent Claims 6, 8, 10-11 (of 1), and 20, 22-24 (of 17) are rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as being unpatentable over D'ALESSANDRO in view of RIORDAN et al or vice versa as applied to claims 1-3, 5-18, 17-18, 20-30 above, and further in view of KESEL.**

The teachings of D'ALESSANDRO in view of RIORDAN et al or vice versa is cited above.

**As for dep. claims 6, 8, 10 (of 1), 20, 23, 24 (of 17),** in a similar marketing method for collecting consumer data with respect to sale, KESEL is cited to teach well known concept of consumer providing feedback (or evaluation data) to the evaluator (evaluation processor), the feedback containing performance evaluation data of the organization (department store) including employee (sale person) and specific employee service evaluation, i.e. behavior, attitude, accessibility, etc., so evaluator can analyze, and report the information back to the provider for evaluation of service provided, thus ensuring consumer high satisfaction and perceptions about goods and services provided by the organization (department store) {see Fig. 4, Tables 2-3, c5:35-65, c6:1-10, c1:15-20}. It would have been obvious to modify the teaching of D'ALESSANDRO / RIORDAN et al or vice versa by including the specific evaluation data of the employee involved in the transaction as taught by KESEL for the purpose of ensuring high satisfaction and perceptions about goods and services provided by the organization (in this case, the sale person). As for the assignment of the unique identifier for any party involved, this is fairly taught in D'ALESSANDRO (c6:35-45 "organization, or customer or employee") and would have been obvious to apply the same teaching to any party desired.

**As for dep. claim 11 (of 1), 22 (of 17),** which deals with transmitting the result to the manager/administrator, this is taught in D'ALESSANDRO c5:60-c6:2.

In summary, as shown in the Background of the Invention, page 1, line 25 to page 2, line 3, the kernel of the invention appears to be dealt with a new

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communications technologies to provide rapid, instant customer feedback such as Internet technologies. This is fairly taught in D'ALESSANDRO. The carrying out or adjustment of the surveying/consumer feedback parameters, i.e. type of organization, product or service, survey format, etc. (see Fig. 4-5 of KESEL or col. 3 of D'ALESSANDRO) are considered as optimizing operating conditions or result effective parameters/variables (surveying/consumer feedback parameters) and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3, 5-16, 17-18, 20-30, 31-38 of the previous office action have been considered but are moot in view of the new ground(s) of rejection and applicant's amendments of the independent claims.

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9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Information Help Line	1-800-786-9199

dtn

  
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